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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/098,204 06/16/98 UDELL

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EXAMINER

LMC1/0913

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ART UNIT

PAPER NUMBER

2756

DATE MAILED:

09/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/098,204

Applicant(s)

Udell et al

Examiner

Thong Vu

Group Art Unit

2756

☒ Responsive to communication(s) filed on Jul 17, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2756

1. This office action is in response to Amendment A filed Jul 17, 2000. Amended claims 1,6,14,17-19 and new claim 44 are pending. Claims 11,16 are canceled. The rejections cited are as stated below.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10,13-15,17-19,44 are rejected under 35 U.S.C. § 102[b] as being unpatentable over MacPhail [4,899,299]

3. As per claim 1, MacPhail discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete a document to which the executable module is attached when a predetermined condition is met; attaching the executable module to the document [MacPhail col 2 line 35-col 3 line 50].

4. As per claim 2-4, MacPhail discloses the executable module is an executable code or program or module or macro as sub-action menu [MacPhail col 6 line 10-40].

5. As per claims 5,13 MacPhail discloses the step of executing the executable module when the document is opened or see the mail [MacPhail Fig 4a].

6. As per claims 6-9 contain the similar limitations set forth of method claims 1-4.

Therefore, claims 6-9 are rejected for the same rationale set forth claims 1-4.

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7. As per claims 10 and 44, MacPhail discloses the executable module is configured to overwrite the message with null characters or update content [MacPhail Fig 4b].

8. Claim 11 is canceled. Claim 12 is depend on claim 11. Therefore claim 12 is also canceled.

9. As per claim 13, MacPhail discloses the executable module is configured to execute when the e-mail message to which it is attached is opened as a design choice of electronic document or Email [MacPhail col 2 line 35-col 3 line 50].

10. As per claim 14, MacPhail discloses the executable module is configured to begin execution when the e-mail message to which it is attached is opened, the executable module deleting the message during said execution if a predetermined condition is met as a design choice of electronic document or Email [MacPhail col 2 line 35-col 3 line 50].

11. As per claim 15, MacPhail discloses the e-mail message is an e-mail message attachment as a design choice of electronic document or Email [MacPhail col 2 line 35-col 3 line 50]..

12. As per claim 17, MacPhail discloses said predetermined condition is printing, copying or forwarding the e-mail message as a design choice of electronic document or Email [MacPhail col 2 line 35-col 3 line 50]..

13. As per claim 18, MacPhail discloses the document is an encrypted document, and wherein the executable module is configured to instruct the computer to decrypt the document if a predetermined condition is met, and to delete the document if the predetermined condition is not met as a design choice of electronic document [MacPhail col 2 line 35-col 3 line 50]..

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14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-43 are rejected under 35 U.S.C. § 103 as being unpatentable over MacPhail [4,899,299] in view of Forsen [6,073,166]

15. As per claim 20, MacPhail taught a method for creating a virtual container containing a digital object, comprising the steps of creating a virtual container, the virtual container residing in contiguous locations in an electronic storage media of a computer, the virtual container including a header portion and a digital object portion; selecting a digital object for insertion into the virtual container; applying an encryption technique to the digital object to create an encrypted digital object; writing the encrypted digital object into the digital object portion; selecting an expiration date for the digital object [MacPhail col 2 line 35-col 3 line 50]. However MacPhail did not explicitly detail writing information indicative of the expiration date into the header portion of the Virtual container. Forsen taught the system for transfer of data including the Internet Mail content an address header, content header, a executable module [Forsen col 2 line 20-45,55-col 3 line 60]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique using header with executable module as taught by Forsen into the MacPhail system in order to utilize the automatically deleted electronic document process on Internet Mail.

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16. As per claims 21-23 contain the similar limitations set forth of method claim 20.

Therefore, claims 21-23 are rejected for the same rationale set forth claim 20.

17. As per claim 24, MacPhail-Forsen disclose the step of creating a container header and an digital object header, the container header containing information regarding the container including a container name, tile digital object header containing information regarding tile digital object [Forsen Fig 1,2]

18. As per claims 25-34 contain the similar limitations set forth of method claims 20 and 24.

Therefore, claims 25-34 are rejected for the same rationale set forth claims 20 and 24

19. As per claims 35, MacPhail-Forsen taught the container header and the digital object headers, and wherein each digital object is located adjacent to its respective digital object header in the virtual container [Forsen col 2 line 20-45]

20. As per claims 36-43, MacPhail-Forsen taught the digital object is document [MacPhail col 2 line 35-col 3 line 50].

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 6:30AM- 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Mark Rinehart*, can be reached at (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to :

Commissioner of Patent and Trademarks

Washington , D.C. 20231

or faxed to :

(703) 308-9051, (for formal communications intended for entry)

Or:

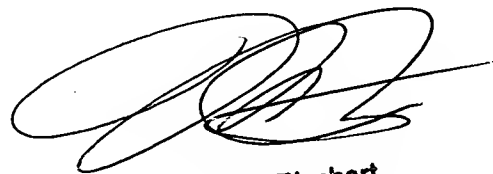
(703) 305-7201 (for informal or draft communications, please label

“PROPOSAL” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu

Sep 9, 2000



Mark H. Rinehart
Primary Examiner